

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-18 are pending in the application, with claims 1-4 and 18 being the independent claims. New claims 5-18 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Support for the claim amendments appear throughout the specification. In particular, support for the amendment to claim 1, and new claims 5 and 6 appears, for example, in Fig. 9 and at paragraphs [0040]-[0043] of the specification. Support for new claims 7-12 appears, for example, in Figs. 1 and 5, and at paragraph [0034] of the specification. Support for new claim 13 appears, for example, in original claim 3, and at paragraph [0035] of the specification. Support for new claims 14-17 appears, for example, in Figs. 10 and 11 and at paragraphs [0034]-[0045] of the specification. Support for new independent claim 18 appears for example, in Fig. 12 and at paragraph [0046] of the specification.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 102***

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,391,541 to Petersen *et al.* ("Petersen").

**Claim 1**

Claim 1 has been amended to recite “an extracting portion from which the nucleic acid from the holding portion is extracted.” Claim 1 has also been amended to recite “a vertical circuit passage, wherein the specimen introducing portion and the extracting portion are joined to a top of the passage through the holding portion, wherein the discharging portion is joined to a bottom of the passage, and wherein the wash storage and the elute storage are joined to a vertically intermediate portion of the passage.” This configuration of the vertical circuit passage is best illustrated in Fig. 9 of the present application, showing a specimen introducing portion 22 and an extracting portion 35 joined to a top of a vertical circuit passage 27 through a holding portion 29, a discharging portion 25 joined to a bottom of the passage, and a wash storage 26 and an elute storage 24 joined to a vertically intermediate portion of passage 27.

Petersen does not disclose the claimed configuration. The Examiner asserts that Petersen discloses a wash storage (wash chamber 66), an elute storage (reagent chamber 67), a holding portion (sample chamber 65), and a discharging portion (waste chamber 68). See Office Action, page 2. As illustrated by Fig. 9 of Petersen, the wash and reagent chambers 66 and 67 are joined to an end of channel 117 upstream of the location at which sample chamber 65 joins to channel 117, and waste chamber 68 is joined to a channel 112, downstream of channel 117. Thus, even assuming, *arguendo*, that sample chamber 35 is connected a top of a vertical passage and waste chamber 68 is joined to a bottom of the passage, the wash and reagent chambers 66 and 67 are not joined to a *vertically intermediate portion of the passage*, as provided by amended claim 1. Further, the Examiner asserts that Petersen discloses an extracting portion (reaction vessel 42)

(see Examiner's rejection of claim 3, Office Action, page 3). Reaction vessel 42 does *not* join to a top of a vertical circuit passage through sample chamber 65, as provided by amended claim 1. As shown by Figs. 3 and 9 of Petersen, reaction vessel 42 and sample chamber 65 are disposed on opposite ends of the device, with reaction vessel 42 being joined to a channel 80, which joins to a U-shaped channel 122. See Figs. 3 and 9, and col. 6, ln. 64-col. 17, ln. 4 of Petersen.

Thus, Petersen does not teach or suggest an extracting portion joined to a top of a vertical circuit passage through the holding portion, a discharging portion joined to a bottom of the passage, and a wash storage and an elute storage joined to a vertically intermediate portion of the passage, as claimed. Applicants therefore respectfully request that rejection be withdrawn.

#### **Claims 2 and 4**

Claim 2 has been amended to recite that “the specimen introducing portion, the holding portion, the wash storage, the elute storage, and the discharging portion are *formed in* the single base.” Claim 4 has been amended to recite that “the specimen introducing portion, the holding portion, the extracting portion, and the discharging portion are *formed in* the base.” For example, an elute storage 14 formed in a base 2 is shown in the sectional view of Fig. 4 of the present application. Petersen does not disclose or suggest the claimed portions and storages being formed in the base, as claimed. The Examiner asserts that the Petersen device has a single base (bottom piece 26 of Fig. 1). See Office Action, pages 2 and 3. Inlet port 64, sample chamber 65, wash chamber 66, waste chamber 68, reagent chamber 67 of the Petersen device, which the Examiner asserts as corresponding to the claimed portions and storages, are formed in a

top piece 22 and a middle piece 24, which are attached to the base 26. The inlet port and chambers of Petersen are not *formed in* the base 26, as claimed. Applicants therefore respectfully request that rejection be withdrawn.

### **Claim 3**

The Examiner asserts that Petersen discloses grooves "provided *on*" the base, identified as bottom piece 26 of Fig. 1. See Office Action, pages 2 and 3. However, claim 3 recites that the grooves are "provided *in*" the base. Petersen discloses channels formed in middle piece 24. See col. 5, lns. 36-37 and Fig. 4 of Petersen. Petersen does not disclose grooves "provided *in*" the base 26, as claimed. Applicants therefore respectfully request that rejection be withdrawn.

### **New Claims 5-18**

New claims 5 and 6 depend from claim 1; therefore these claims are allowable for at least the same reasons as discussed above with respect to claim 1. Applicants respectfully request that these claims be allowed.

New claims 7 and 8 depend from claim 2; therefore these claims are allowable for at least the same reasons as discussed above with respect to claim 2. Further, claim 7 recites a heater provided on the base, and claim 8 recites that the base is formed with a slope, the slope being slanted downward toward the holding portion, and the heater being provided on the slope. Petersen does not disclose or suggest the claimed heater or the claimed slope. Applicants respectfully request that these claims be allowed.

New claims 9, 10, and 14-17 depend from claim 3; therefore these claims are allowable for at least the same reasons as discussed above with respect to claim 3. Further, Petersen does not disclose or suggest the claimed heater or the claimed slope

recited in claims 9 and 10, respectively. Petersen also does not disclose or suggest the features recited in claims 14-17. Applicants respectfully request that these claims be allowed.

New claims 11-13 depend from claim 4; therefore these claims are allowable for at least the same reasons as discussed above with respect to claim 4. Further, Petersen does not disclose or suggest the claimed heater or the claimed slope recited in claims 11 and 12, respectively. Petersen also does not disclose or suggest grooves formed in the base as recited in claim 13. Applicants respectfully request that these claims be allowed.

New independent claim 18 recites a device for pretreating a specimen having “first and second tanks, wherein either the first or second tank is selected to have a specimen supplied and electrophoresed therein; and a holding portion for holding a nucleic acid liberated from the electrophoresed specimen, the holding portion being disposed between the first and second tanks, wherein the first and second tanks are sloped at respective bottom surfaces thereof upward to the holding portion.” Petersen does not disclose or suggest the device of new claim 18. Applicants therefore respectfully request that claim 18 be allowed.

### ***Other Matters***

The Examiner indicated on page 4 of the Office Action that the following references are made of record: U.S. Pat. Nos. 6,422,249 to Certa *et al.* and 6,644,104 [sic, 6,664,104] to Pourahmadi *et al.* However, these references are not listed on the Notice of References Cited (PTO-892 form). Applicants respectfully request the next

Office Communication includes a Notice of References Cited listing these two references.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Anbar F. Khal  
Attorney for Applicants  
Registration No. 59,088

Date: 1-21-09

1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600  
927073\_1.DOC